

## REMARKS

### File History

Claims 1-5, 8-21, 25-26, and 28-35 were previously pending in the application. In the outstanding Final Office action (FOA) of 11/22/2010, the following rejections, objections, requirements and other actions appear to have been made:

- **Claims 1-4, 8-11, 13-21, 25-26, and 28-31** were rejected under 35 USC §103(a) as being obvious over Mori et al. (US 6,326,981) {= ref #1} as combined with Official Notice {1.5} and as further combined with Martin et al. (US 6,714,206) {= ref #2} { FOA pg. 6, ¶ 7 }
- **Claims 5, 12** were rejected under 35 USC §103(a) as being obvious over Mori {1} as combined with Official Notice {1.5} and with Martin {2} and as further combined with Francis (US 5,841,411) {= ref #3} { FOA pg. 21, ¶ 8 }
- **Claims 32-35** were rejected under 35 USC §103(a) as being obvious over Mori {1} as combined with Martin {2} and as further combined with Ahn (7,259,755) {= ref #4} { FOA pg. 23, ¶ 9 }
- **Claims 32-34** (and their dependencies) were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. { FOA pg. 4, ¶ 5 }

### Summary of Current Response

Claims 1-4, 8, 13, 15, 17, 20 are amended

### Support for amendments

Application Fig. 2 shows a primitive repeating group 202 having an even number of subpixels in each of its defined rows and at least one column (106) of same color. More specifically in Fig. 2, the top row is shown to be R, (G/2), B, (G/2) where G/2 indicates a smaller width Green and the lower row is shown to be B, (G/2), R, (G/2).

In application Fig. 6, the primitive repeating group is identified as 602 and its two rows are R, (B/2), G, (B/2) where B/2 indicates a smaller width Blue for the top row and G, (B/2), R, (B/2) for the bottom row. The dot polarity violation is identified as occurring within region 606.

### **Applicant's Overview of the outstanding grounds of rejection**

From Applicant's perspective and with due respect, the Examiner appears to be insisting that he will be the one who defines what a "repeating group" is and insisting that the totality of definitions in the claims and specification are to be ignored.

More specifically, with regard to Claim 32, the Examiner elects to read in isolation the text string "the primitive subpixel repeating group being a smallest chooseable repeating group among possible repeating groups substantially tessellating the panel". However, and again with due respect, Claim 32 has a combination of constraints for defining said primitive subpixel repeating group, not just that one text string in isolation.

The Examiner insists that any two adjacent subpixels (e.g., "RB" OR "GB") satisfies all the requirements of Claim 32.

Applicant respectfully submits that this cannot logically be true. The two adjacent subpixels "RB" do not create a situation wherein satisfaction is provided for "the panel being substantially tessellated by [[ the ]] primitive subpixel repeating group" [bracketed text and emphasis added] as set forth in Claim 32. Thus the outstanding grounds of rejection are believed to be based on an illogical construction of the claim taken in whole and in consideration of the rest of the specification.

Applicant was responding to the Examiner's step of choosing two adjacent primitives in one of the references (Mori) and arbitrarily calling that a subpixel repeating group. However, it is not a primitive repeating group but rather a combination of primitive repeating groups.

It is respectfully submitted that an appropriate explanation has been provided with regard to Claims 32-34. Reconsideration is respectfully requested.

#### **Traverse of Official Notice**

Applicant respectfully traverses the taken Official Notice at FOA page 7 that a violated dot inversion is part of the prior art and Applicant respectfully request substantiating evidence for said allegation.

#### **Traverse of Proposed Modification**

Mori teaches an odd number of subpixels per row in his "primitive repeating group". However the claims call for an even number per row.

The PTO has not shown that an even number per row can work with two-line dot inversion. It is respectfully submitted that the PTO is engaging in hindsight lifting of Applicant's teachings rather than showing two-line dot inversion being used in the prior art in combination with tessellation primitives having an even number of subpixels per row.

#### **Traverse of Defining Martin as having "rows"**

While the PTO has a right to broadly construe claim terms, that right is not unbounded. It must reasonably conform to Applicant's specification.

Martin does not have "rows" in his 5 subpixel primitive where each "row" has at least 3 different colors and where the word "row" is taken in a sense that is reasonable to the way the same is used in Applicant's specification. The middle Blue of Martin's primitive is not inline and thus not in a "row" with the R and the G subpixels.

### Traversal of combining Mori and Martin

Generally, when the teachings of two references are combined, it is because the ordinary artisan is alleged to have spotted a problem and to have recognized that the art-recognized problem could be (obviously) solved by combining the teachings. However, in the outstanding grounds of rejection, no problem is articulated as a reason for combining references and selectively picking and choosing from each. The only conclusion left is that impermissible hindsight is being used to pick and choose from random pieces of art so as to thereby follow the blueprint provided only by Applicant's disclosure.

Since the present application has been finally rejected numerous times on bases that appear to be not in accordance with law, Applicant respectfully submits the following end notes for further consideration:

END NOTES: (These end notes are provided here as additional authoritative support for legal arguments made above. End Note#1 supports the requirement for considering the claim in whole with **all** its limitations. End Note#2 is directed to the basics of an anticipation rejection. End Note#3 is directed to the requirement for a rational underpinning. End Note#4 is directed to the prohibition against making assumptions.)

#### [[End Note #1]]:

When determining whether a claim is obvious, an Examiner must make "a searching comparison of **the claimed invention – including all its limitations** – with **the teachings** of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness **requires a suggestion** of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir.

2006), the Supreme Court noted that "[t]o facilitate review, this [obviousness] analysis should be made explicit."

[[Note this passage extracted from the BPAI decision of Ex Parte 6695510 et al (Ex parte Wyeth) Appeal No. 2009008674, decided 02/04/2010, reported at for example:

<http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2009008674-02-04-2010-1>

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**[[End Note #2]]:**

A single prior art reference that discloses, either *expressly* or *inherently*, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. See *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). "Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates." *Id.* (quoting *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

[[Note this passage extracted from the BPAI decision of Ex Parte Matsubara et al Appeal No. 2009006581, decided 02/10/2010, reported at for example:

<http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2009006581-02-10-2010-1> ]]

**[[End Note #3]]:**

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in *the prior*

*art as a whole* or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). **These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.** Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ... The examiner may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions **or hindsight reconstruction** to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). ... The mere fact that prior art may be modified in the manner suggested by the Examiner [*to produce the claimed invention*] does not make the modification obvious unless the prior art [*when viewed in whole*] suggested the desirability of the modification. ... One cannot use hindsight reconstruction to pick among isolated disclosures in the prior art to deprecate the claimed invention. ... **It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art** so that the claimed invention is rendered obvious. .... The Examiner can satisfy [his/her prima facie] burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

**[[End Note #4]]:**

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, **resort to speculation, unfounded assumptions or hindsight reconstruction** to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017 (CCPA 1967). Further, in rejecting claims as unpatentable on the basis of obviousness, the Examiner must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l. Co. v. Teleflex, Inc., 550 U.S. 398, 418 (2007).

In other words, it is improper to base a conclusion of obviousness upon facts gleaned only through hindsight. "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)). "The invention must be viewed not after the blueprint has been drawn

by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.” Id. (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138 (Fed. Cir. 1985)).

To support a conclusion that a claim is directed to obvious subject matter, prior art references must suggest expressly or impliedly the claimed invention or an Examiner must present a “convincing line of reasoning” as to why one of ordinary skill in the art would have found the claimed invention to have been obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). When determining whether a rejection based on design choice is appropriate, the Examiner must review the Specification and ascertain if the limitation in question is disclosed as serving any advantage or particular purpose, or whether it solves a stated [[ and thus recognized ]] problem. The Examiner also should explain the reasoning used to determine that the prior art would have performed equally as well as the claimed invention. These two steps help present the aforementioned “convincing line of reasoning.” *Ex parte Clapp*, 227 USPQ at 973.

[[Note this passage extracted from the BPAI decision of Ex Parte Rohrer et al Appeal No. 2009001292, decided 02/05/2010, reported at for example:

<http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2009001292-02-05-2010-1> ]].

### CONCLUSION

It is believed that all outstanding grounds of rejection have been overcome or traversed in light of the foregoing. Applicant respectfully requests entry of the amendments and reexamination with favorable outcome. Continued examination (RCE) is requested pursuant to 37 CFR 1.114.

Authorization is hereby given to charge any fees due or credit any overpayments in regard to this communication to deposit account 50-5029. If the Examiner has any questions or concerns, a telephone call to the below listed attorney at (408) 331-1675 is welcomed and encouraged.

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Respectfully submitted,

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